THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte DONALD W. KELLEY

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Appeal No. 94-1550
Application 07/893,662[1]

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ON BRIEF

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Before KIMLIN, JOHN D. SMITH and WEIFFENBACH, Administrative Patent Judges.

JOHN D. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal pursuant to 35 U.S.C. § 134 from the final rejection of claims 1 through 20.

Claim 1 is representative and is reproduced below:

1. A biologically active ingredient containing liquid formulation for depositing the active ingredient on a substrate

[1] Application for patent filed June 5, 1992. According to appellant, this application is a continuation-in-part of Application 07/670,306 filed March 15, 1991, now abandoned.

when the formulation is applied to the substrate which consists essentially of:

an effective amount of a biologically active ingredient;

a fluorinated acrylic copolymer in an amount effective to make said active ingredient resistant to removal or dilution by water or oil after deposition of the active ingredient onto said substrate; and

a solvent selected from water, organic solvent or a mixture of water and organic solvent,

said ingredient being selected from the group consisting of insect and animal repellents, insect and animal attractants, insect and plant growth regulators, pesticides, sunscreen agents and medicines for topical application.

The references of record relied upon by the examiner are:

Dessaint et al. (Dessaint)	4,478,975	Oct. 23, 1984
Levy[2]	4,983,390	Jan. 8, 1991

A reference referred to in the argument section of appellant's Brief is:

Delescluse	4,366,300	Dec. 28, 1982

The appealed claims stand rejected for obviousness (35 U.S.C. § 103) over Dessaint.

The subject matter on appeal is broadly directed to a liquid formulation which "consists essentially of" an effective amount

[2] Levy was discussed by the examiner in the Supplemental Answer (Paper No. 12 filed February 7, 1994).

of certain broad classes of biologically active ingredients[3], including, inter alia, insect repellents and pesticides, in a combination with a fluorinated acrylic copolymer and a solvent. The fluorinated acrylic copolymer is present in an amount effective to make the active ingredient resistant to removal or dilution by water or oil after depositing the formulation onto a "substrate." For example, when applied as an insect repellent containing composition to a dog (i.e., a "substrate"), the claimed fluorinated acrylic copolymer formulation retains its effectiveness against insects, even after the dog is subjected to rain or sprinkling. See the Specification at page 5. It is important to note that appellant defines the term "substrate" as not only including animate objects such as dogs, other animals, and humans but also as inclusive of inanimate objects such as wood, concrete, metal, tile, textiles and plastics. See the Specification at page 17, lines 20-25.

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[3] The biologically active ingredients specifically recited in appealed claim 1 include the Markush grouping of insect repellents, animal repellents, insect attractants, animal attractants, insect regulators, plant growth regulators, pesticides, sunscreen agents and medicines. No question of misjoinder was raised in the prosecution of this application nor was an election requirement imposed. Further, no explanation is of record how a sunscreen agent acts as a biologically active ingredient. In the event of any further prosecution of this application, the examiner may wish to consider these matters.

As evidence of obviousness of the subject matter defined by the appealed claims, the examiner principally relies on Dessaint. This reference discloses a formulation which includes a fluorinated acrylic copolymer contained in an organic solvent which is used to waterproof or oilproof construction materials such as wood, concrete, metal and plastic thus rendering these materials resistant to soil, graffiti and bill posting. See Dessaint at column 1, lines 6-13.

Apparently recognizing that Dessaint contains no express disclosure of a biologically active ingredient as defined and required by the appealed claims, the examiner alleges in the Answer at page 3 that

> [i]t is well known in the art to incorporate various agents such as drugs, sunscreens, attractants, repellents, etc. depending on the substrate used (bait, human skin, vegetation, etc.), in compositions that contain fluorinated acrylates as oil/water repellents.

When challenged to provide factual support for this all encompassing contention of what is well known in the art, the examiner cited Levy. However, as noted in appellant's Reply Brief, Levy does not provide factual support for the examiner's contention.

It is not uncommon that the rationale supporting an obviousness rejection is based on either common knowledge in the art or "well-known" prior art. As set forth in the M.P.E.P § 2144.03, page 2100-115, revision 2, July 1996, an examiner may take official notice of facts outside the record so long as such facts are capable of instant and unquestionable demonstration as being "well-known" in the art. Typically, such official notice of facts is used to supplement or clarify the teaching of a reference disclosure or to justify a particular inference to be drawn from a reference teaching. Thus facts "so noticed" serve to "fill in the gaps" which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection. However, it is improper to take official notice of facts which comprise the principal evidence upon which a rejection is based. In re Ahlert, 424 F.2d 1088, 1092, 165 USPQ 418, 421 (CCPA 1970) ("[w]e know of no case in which facts judicially noticed comprised the principal evidence upon which a rejection was based or were of such importance as to constitute a new ground of rejection when combined with the other evidence previously used."). Here, the examiner's statement of what was allegedly "well known" in the prior art is so broad and all inclusive that it is tantamount to a statement that what is

defined in the appealed claims is anticipated by well known prior art. Further, when challenged[4] by appellant, the examiner was unable to provide an "instant and unquestionable demonstration" that the facts taken notice of were indeed "well known" in the art. Accordingly, the evidentiary record provided by the examiner in this appeal falls far short of that required to establish a prima facie case of obviousness for the claimed subject matter. Nevertheless, as discussed below, there is evidence in the appeal that factually supports the examiner's contention that it would have been obvious to a person ordinary skill in the art to add a "pesticide" to the formulation of Dessaint motivated by reasonable expectation of success. See the Answer at page 4.

In their Brief at page 3, appellant argues that the claim language "consists essentially of" in appealed claim 1 makes it clear that appellant's claims do not cover a formulation which includes a polyurethane. Appellant further contends that the Dessaint compositions, as shown by the examples, require the

[4] An applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. Such a challenge should contain "adequate information or argument so that on its face it creates a reasonable doubt" regarding the notice taken. In re Boon, 439 F.2d 724, 728, 169 USPQ 231, 234 (CCPA 1971).

presence of a substantial amount of polyurethane. In support of this argument, appellant refers to the file wrapper of the Dessaint patent in which the Dessaint invention was characterized as containing four "essential" constituents inclusive of a polyurethane component. This argument was apparently made in that prosecution to distinguish the Dessaint claims from the disclosure of U.S. Patent No. 4,366,300 to Delescluse. See the letter attached as Appendix II to appellant's Brief.

Like Dessaint, Delescluse also discloses a formulation which includes a fluorinated acrylic copolymer in an organic solvent used to protect construction materials against spotting or staining, for example, from unlicensed bill-sticking and projections or spraying of liquid paints (i.e., graffiti). See Dessaint at column 1, lines 6-20. More specifically, Delescluse teaches that the protection may be provided against deposits or stains from atmospheric dust with eventual development of vegetative mosses (column 1, lines 14-16). Importantly, Delescluse further teaches that if it is desired to increase the fungal or bactericidal protection of such materials, anticryptogamic agents (agents which exhibit fungistatic or fungicidal action) or bactericides may be incorporated into such

compositions "without inconvenience." See the reference at column 3, lines 48-51.

In light of the disclosure in Delescluse, it would have been obvious to a person of ordinary skill in the art to incorporate a fungicide in the formulations disclosed by Dessaint. That the language defining appellant's pesticide ingredient (for example, as broadly set forth in appealed claim 1 and claim 6) covers a fungicide cannot be disputed by appellant. Indeed, appellant broadly defines a "pesticide" as inclusive of a parasiticide (Specification, page 16, lines 27-28) and appellant discloses the specific use of triforine[5] (Specification, page 17, line 3), a well known fungicide.

Returning to appellant's argument regarding the "consists essentially of" claim language, it is clear that appellant's broad claims do in fact cover a formulation which includes a polyurethane. As set forth earlier, appellant contemplates the use of his compositions on inanimate objects including wood and masonry and appellant has made no showing that the inclusion of a polyurethane in a composition used to coat an inanimate object would materially affect the basic and novel characteristics of

[5] See the Merck Index, 11th edition, published by Merck & Company, copyright 1989, page 1524. A copy of this publication is attached.

his formulation. In any event, the Delescluse reference clearly describes an analogous formulation containing a fluorinated acrylic copolymer not containing a polyurethane component.

We have also fully considered the Rule 132 Declaration presented by inventor Kelley which is of record and argued in appellant's Brief. How the results of this Declaration which compare a formulation with and without a specific insecticide (Pyrethrin) are relevant to a rejection based on prior art disclosures of the use of fungicides is not apparent.

Finally, appellant contends that he has discovered that the addition of a fluorinated acrylic copolymer to an active ingredient containing liquid formulation unexpectedly protects the active ingredient from removal or dilution by water or oil. We cannot subscribe to this argument. In our view, the addition of a fluorinated acrylic copolymer, disclosed in Dessaint as having known waterproofing and oilproofing properties, would have been expected to protect the active ingredient against removal or dilution by water or oil.

In light of the foregoing discussion, we affirm the examiner's obviousness rejection of appealed claims 1, 6 and 12-18, since each of these claims cover a pesticide (fungicide) ingredient. We reverse the examiner's rejection as to appealed

claims 2-5, 7-11, 19 and 20 essentially for the reasons set in appellant's briefs. Inasmuch as our affirmance of the claims 1, 6 and 12-18 is based on specific teachings in the Delescluse patent, we denominate the affirmance as involving a new rejection under 37 CFR § 1.196(b). Accordingly, the decision of the examiner is affirmed-in-part and our affirmance is denominated as a new rejection.

Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based upon the same record must be filed within one month from the date hereof (37 CFR 1.197).

With respect to the new rejection under 37 CFR 1.196(b), should appellant elect the alternate option under that rule to prosecute further before the Primary Examiner by way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire two months from the date of this decision. In the event appellant elects this alternate option, in order to preserve the right to seek review under 35 U.S.C. 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before

the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to us for final action on the affirmed rejection, including any timely request for reconsideration thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART, 1.196(b)

EDWARD C. KIMLIN Administrative Patent Judge	)
JOHN D. SMITH Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
CAMERON WEIFFENBACH Administrative Patent Judge	)

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Application 07/893,662

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